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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,186	10/03/2000	Jay S. Walker	00-033	7415
22927	7590	07/24/2006	EXAMINER	
WALKER DIGITAL 2 HIGH RIDGE PARK STAMFORD, CT 06905			NGUYEN, BINH AN DUC	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,186

Applicant(s)

WALKER ET AL.

Examiner

Binh-An D. Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

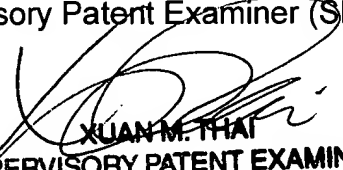
In view of the Appeal Brief filed on May 31, 2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


XUAN M. THAI
SUPERVISORY PATENT EXAMINER
TC3700

The rejection of claims 73 and 74 under 35 U.S.C. 101 are hereby withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 40-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier et al. (5,871,398) in view of Nguyen (6,857,959).

Referring to claims 40, 69, 70, 73, and 74, Schneier et al. teaches a gaming system and method (or medium storing instructions adapted to be executed by a processor to perform the method) comprising: a processor; and a storage device in communication with said processor and storing instructions (15:54-16:4) adapted to be executed by said processor to receive from a device information regarding a total payout amount of electronic scratch-off lottery tickets stored on the device, wherein the total payout amount has not been disclosed to the player (5:55-6:20; 11:23-32; 16:35-40). Schneier et al. does not explicitly teach receiving from a player an indication of an item that the player is interested in winning; determine a value of the item; and arrange for the player to receive the item based on whether the total payout amount is within a defined range of the value of the item. Nguyen, However, discloses a gaming machine having a memory storing a list of one or more prizes, a prize display for viewing prize information, a prize selection mechanism that allows a user playing a game on the gaming machine to indicate of an item that the player is interested in winning (1:5-10; 3:29-35); determine a value of the item (4:35-47); and arrange for the player to receive the item based on whether the total payout amount is within a defined range of the value of the item (12:20-33, Fig.7). Nguyen further suggests the gaming machine may be utilized for a lottery game (3:37). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the lottery system of Schneier et al. with the prize selection gaming system of Nguyen to come up with a

gaming system that allows the player to select the prizes that may be won where the odds of winning the prize are a function of the prize selected.

Referring to claim 41 Nguyen teaches the item comprises a product (e.g., merchandise)(4:23-25).

Referring to claims 42 and 72 Nguyen teaches receiving from a player device (3:46-50).

Referring to claim 43 Nguyen teaches receiving from a device is performed via a gaming device (3:46-50).

Referring to claims 44 and 45 Nguyen teaches the indication includes an item identifier (e.g., prize information)(3:46-50) or player-selected item price (e.g., player selecting shopping sprees or cash)(3:65-66).

Referring to claim 46 Nguyen teaches the information regarding a total payout amount includes a probability of the player receiving the item (e.g., odd of winning prize)(8:61-9:12).

Referring to claims 47-49, Schneier et al. teaches the information regarding a total payout amount includes a player identifier (4:47-5:18), a game event identifier (4:47-5:18), and a pre-stored outcome (6:8-15).

Referring to claim 50 Nguyen teaches displaying a list of available items to the player and wherein receiving the indication of the item includes receiving a selection from the list of available items (3:46-51; 4:8-47).

Referring to claim 51, wherein in response to the received indication, offering to provide a substitute item to the player, and wherein arranging includes arranging for the

player to receive the substitute item based on whether the total payout amount is within a defined range of the value of the substitute item, it is notoriously well known to provide a substitute product or item to a person when the requested item is not available or out of stock and/or the substitute item is similar but cheaper in price.

Referring to claim 52 wherein receiving the indication of the item includes receiving an indication that the player is interested in purchasing the item, this limitation is notoriously well known in gaming redemption which exchanges winning credit/outcome for the item or purchasing the item using game credits.

Referring to claim 53 Nguyen teaches charging the player a fee to play the electronic lottery game to win the indicated item (8:14-60).

Referring to claim 54, Schneier et al. further teaches the electronic scratch-off lottery tickets are associated with a lottery provider (5:56-6:20). Schneier et al. does not explicitly teach arranging for the player to receive the item includes arranging for the player to receive the item from a retail store where the item is offered for sale. Nguyen, however, teaches arranging for the player to receive the item includes arranging for the player to receive the item from a retail store where the item is offered for sale (14:63-66). It would have been obvious to combine Nguyen's teaching of utilizing retail stores as a prize supplier to the lottery system of Schneier et al. simplify the prize fulfillment process at the lottery center and provide faster delivery of the product to the winners.

Referring to claim 56, wherein the indication of the item comprises an item cost, this limitation is inherent from Nguyen's teaching of the prize includes cash, i.e., \$1000 (Fig.2).

Referring to claim 57, Nguyen teaches arranging for the player to receive the item is further based on information associated with the player (e.g., winning status)(12:17-19).

Referring to claim 58, Nguyen teaches transmitting a transaction request, including the total payout amount, to a merchant device (e.g., fulfillment center); and receiving a transaction response from the merchant device, wherein arranging for the player to receive the item is further based on the transaction response (14:55-15:2).

Referring to claim 59, wherein arranging for the player to receive the item further comprises converting the total payout amount to an alternate currency associated with a merchant, it is notoriously obvious to exchange or redeem winning lottery ticket at a retailer wherein the winning ticket's value is converted to equivalent cash or currency at the store, e.g., a person bought a scratch-off lottery ticket at a store and won \$10, he then cashed out the ticket at the store for \$10.

Referring to claim 55 wherein a seller arranges for the item to be provided to the player in exchange for payment of an amount based on a difference between the total payout amount and the value of the item, it is obvious to a person of ordinary skill in the art to exchange or redeem winning lottery ticket at a retailer wherein the winning ticket's value is converted to equivalent cash or currency at the store and buying an item, e.g., a person bought a scratch-off lottery ticket at a store and won \$10, he then cashed out the ticket at the store for \$10, he further bought a \$12 hat, the person would pay \$2 more.

Referring to claim 67, wherein the method further comprising: determining an excess payout amount; and arranging for the excess payout amount to be provided to at the player, similar to the obviousness pointed to claims 55 and 59 above, this limitation is obvious to a person of ordinary skill in the art to exchange or redeem winning lottery ticket at a retailer wherein the winning ticket's value is converted to equivalent cash or currency at the store and buying an item, e.g., a person bought a scratch-off lottery ticket at a store and won \$10, he then cashed out the ticket at the store for \$10, he further bought a \$2 candy bar, the store clerk would give the person \$8 in change.

Referring to claim 60, Nguyen teaches arranging for the player to receive the item further comprises: based on the indication of the item, adjusting information associated with a game event in accordance with a conversion table, e.g., the game machine selects the appropriate pay table for the prize or prizes selected (12:1-19).

Referring to claims 61 and 62, Nguyen teaches arranging for the player to receive the item comprises transmitting information enabling the item to be delivered to the player; and transmitting information enabling the player to take possession of the item (14:55-15:2).

Referring to claim 63, Schneier et al. teaches the information regarding the total payout amount and/or an outcome associated with a game event are not displayed to the player (5:55-6:20; 11:23-32; 16:35-40).

Referring to claims 64 and 65, Nguyen teaches determining an event wager amount; and displaying to the player a required wager amount (8:14-26).

Referring to claim 66, Nguyen teaches the item is provided to the player by a merchant (e.g., vendor)(14:61-66). Regarding the limitation of arranging for the merchant to receive payment in exchange for providing the item to the player, this is inherent from Nguyen's teaching of the prize fulfillment center orders the computer from a vendor and have it shipped to the player (14:61-66).

Referring to claim 68, Nguyen teaches information associated with the item is incorporated into play of a game associated with the total payout amount (8:14-26).

Referring to claim 71, Schneier et al. teaches the storage device further stores an player outcome database and/or a provider outcome database (7:2-26).

Referring to claim 72, Schneier et al. teaches a communication device coupled to the processor and adapted to communicate with a seller device (11:57-12:7, Figs. 4 and 5).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 571-272-4440. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BN


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